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09/867,679	05/31/2001	Martin John Millmore	19111.0057	7209
23517	7590	03/22/2006	EXAMINER	
SWIDLER BERLIN LLP 3000 K STREET, NW BOX IP WASHINGTON, DC 20007			LUU, MATTHEW	
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			3663	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/867,679	<b>Applicant(s)</b> MILLMORE ET AL.	
	<b>Examiner</b> LUU MATTHEW	<b>Art Unit</b> 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 7, the new added limitation “capable of being entered in the one data entry field”, it is unclear whether “the one data entry field” refers to “at least one data entry field” (line 4) or “at least one further data entry field” (line 6).

As shown in Figs. 3 and 4 of the Applicant's drawings, “the one data entry field” (20) and “at least one further data entry field” (22), it appears that for each of at least two data values which are capable being entered in the further data entry field (22), instead of the one data entry field (20) as claimed.

For example, as shown in Fig. 3, if the first data entry field is (20), and the second data entry field is (22), then which data entry field is capable of being entered in the one data entry field, i.e., the first or the second data entry field?

It is unclear where exactly in the specification and drawings that describes the claimed limitation “for the one data entry field, storing data values and corresponding attribute data defining at least one further data entry field for each of at least two data

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values which are capable of being entered in the one data entry field" as recited in claim 1, lines 4-7.

Regarding claim 3, lines 7-8, with respect to the limitation "at least one further data entry field for each of at least two data values which are capable of being entered in the one data entry field", please note the rejection as set forth above with respect to claim 1.

Dependent claims are also considered rejected for incorporating the defects from their respective parent claims by dependency.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day, Jr. et al (4,763,356) (hereinafter Day) in view Kennedy et al (6,651,217).

Regarding claim 3, Day discloses (Figs. 3 and 4) a method for controlling the appearance of a data entry form on a display (form 30 on a display 15). The method comprises the step of causing a data entry form (30) to be displayed on a display (15) in

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accordance with stored attributes (highlighted attribute) (Column 3, lines 47-51). The data entry form (30) having at least one data entry field (Fig. 3, entry field 41), wherein a user can insert the word "CONVERTIBLE" model for the entry field (41). As shown in Fig. 4, upon inserting the name "CONVERTIBLE", the form entry system dynamically altering the data entry form and the display of the data entry form by highlighting the next field and bring up the corresponding tool (50) to fill in that field (Column 3, line 63 to column 4, line 2).

With regard to the amended limitation "displaying at least one further data entry field corresponding to each of at least two data values which are capable of being entered in the one data entry field" (lines 6-8), Day further discloses (Fig. 4) one further data entry field (menu 50) corresponding to each of at least two data value (Year 19780 to year 1986) which are capable of being entered in the one data entry field (Year highlighted box 51).

Furthermore, the statements of intended use or field of use, "operable to", "adapted to", or "**capable of**" clause are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2<sup>nd</sup> 1647.

See MPEP 2114:

“A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2<sup>nd</sup> 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ 2<sup>nd</sup> 1525, 1528.”

As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Day fails to explicitly teaches the step of monitoring data values entered into the at least one data entry field (Claim 3, lines 4-5).

However, it would have been to a person of ordinary skill in the art to recognize that the form entry system of Day would monitor which car model, such as roadster (42), 4 DR. sedan (43), etc. being entered and change the tool menu responsively to the user's selection.

Kennedy (6,651,217), on the other hand, discloses (Fig. 2) a user of client computer (204) visits web site (201) and enters his name, address, and telephone number into form (250), modified web browser (205) associates the values entered by the user with field labels appearing near the values and stores the values into a data structure (206) for future use (Column 6, lines 23-29).

Kennedy further discloses a profile generator function (205c) extracts the name, address, and phone number entered by the user, fills out the corresponding fields in autofill profiled (203) by matching field labels in form (250) with those in autofill profile (203), and prompts the user to fill in missing data items such as e-mail.

When the user has completed the user profiled, the completed form is saved and used as the basis for populating future forms (Column 6, lines 50-58). Kennedy further teaches "In accordance with one aspect of the present invention, data values for the fields that were filled in by the user in Fig. 4 are extracted, matched with the fields in the autofill profile, and presented to the user as shown in Fig. 6" (Column 8, lines 27-31).

Thus, based on this teaching, the form entry system of Kennedy monitors the data values entered by the user, such as his name, address, and telephone number.

Therefore, it would have been obvious to the person of ordinary skill in the art to use the monitoring or matching processed of Kennedy into the form entry system of Day to create a profile generator for storing the car buyer profile for future use.

Regarding claims 10 and 12, Day discloses (Figs. 8-9) a corresponding further data entry field (fields 85-1 to 85-7) is an address entry field having a correct format for

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the address style data value (the dealer address style data value). See column 5, lines 48-58.

On the other hand, Kennedy also discloses (Figs. 7 and 8) a corresponding further data entry field is an address entry field having a correct format for the address style data value (the highlighted autofill address style).

Regarding claim 11, Kennedy discloses (Figs. 7 and 8) the corresponding further data entry field corresponds in form with the data value entered into one data entry field. Figs. 7 and 8 shows different form styles with certain fields highlighted to indicate that they contain automatically suggested values. See column 8, line 54 to column 9, line 13.

Regarding claim 13, Day discloses (Figs. 8-9) wherein the controller (computer 20) further displays a corresponding plurality of further data entry field (fields 85-1 to 85-7) according to the stored attribute data (the dealer address attribute data values). See column 5, lines 48-58.

On the other hand, Kennedy also discloses (Figs. 7 and 8) a corresponding plurality of further data entry fields according to the stored attribute data (the highlighted autofill attribute data).

Regarding claim 14, Kennedy discloses (Figs. 7 and 8) a corresponding plurality of further data entry fields correspond in form with the data value entered into the one



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data entry field. Figs. 7 and 8 shows different form styles with certain plurality of fields highlighted to indicate that they contain automatically suggested values. See column 8, line 54 to column 9, line 13.

Regarding claim 15, Day discloses (Figs. 8-9) a corresponding further data entry field (fields 85-1 to 85-7) indicating a style (the dealer information address style) and the corresponding plurality of further data entry fields (fields 85-1 to 85-7) have correct formats for the indicated style (the dealer address style data value). See column 5, lines 48-58.

On the other hand, Kennedy also discloses (Figs. 7 and 8) a corresponding further data entry fields having a correct format for the address style data value (the highlighted autofill address style).

### ***Claim Rejections - 35 USC § 103***

Claims 1-2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Day in view of Kennedy as applied to claims 3 and 10-15 above, and further in view of Nishiyama et al (6,421,693).

Regarding claim 1, Day discloses (Figs. 3 and 4) a method for controlling the appearance of a data entry form on a display (form 30 on a display 15). The method comprises the step of causing a data entry form (30) to be displayed on a display (15) in accordance with stored attributes (highlighted attribute) (Column 3, lines 47-51). The

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data entry form (30) having at least one data entry field (Fig. 3, entry field 41), wherein a user can insert the word "CONVERTIBLE" model for the entry field (41). As shown in Fig. 4, upon inserting the name "CONVERTIBLE", the form entry system dynamically alters the data entry form and the display of the data entry form by highlighting the next field and bringing up the corresponding tool (50) to fill in that field (Column 3, line 63 to column 4, line 2). Day also discloses (Figs. 8-9) a corresponding further data entry field (fields 85-1 to 85-7) for each of at least two data values (fields 85-1 to 85-7 are at least two data values).

With regard to the amended limitation "at least one further data entry field corresponding to each of at least two data values which are capable of being entered in the one data entry field" (lines 6-7), Day further discloses (Fig. 4) one further data entry field (menu 50) corresponding to each of at least two data values (Year 19780 to year 1986) which are capable of being entered in the one data entry field (Year highlighted box 51).

Furthermore, the statements of intended use or field of use, "operable to", "adapted to", or "capable of" clause are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re*

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Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2<sup>nd</sup> 1647.

See MPEP 2114:

“A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2<sup>nd</sup> 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ 2<sup>nd</sup> 1525, 1528.”

As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Day fails to explicitly teaches the step of monitoring data values entered into the at least one data entry field. Day fails to disclose “entering data into a database”.

However, it would have been to a person of ordinary skill in the art to recognize that the form entry system of Day would monitor which car model, such as roadster

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(42), 4 DR. sedan (43), etc. being entered and change the tool menu responsively to the user's selection.

Kennedy (6,651,217), on the other hand, discloses (Fig. 2) a user of client computer (204) visits web site (201) and enters his name, address, and telephone number into form (250), modified web browser (205) associates the values entered by the user with field labels appearing near the values and stores the values into a data structure (206) for future use (Column 6, lines 23-29).

Kennedy further discloses a profile generator function (205c) extracts the name, address, and phone number entered by the user, fills out the corresponding fields in autofill profiled (203) by matching field labels in form (250) with those in autofill profile (203), and prompts the user to fill in missing data items such as e-mail.

When the user has completed the user profiled, the completed form is saved and used as the basis for populating future forms (Column 6, lines 50-58). Kennedy further teaches "In accordance with one aspect of the present invention, data values for the fields that were filled in by the user in Fig. 4 are extracted, matched with the fields in the autofill profile, and presented to the user as shown in Fig. 6" (Column 8, lines 27-31).

Thus, based on this teaching, the form entry system of Kennedy monitors the data values entered by the user, such as his name, address, and telephone number. Therefore, it would have been obvious to the person of ordinary skill in the art to use the monitoring or matching processed of Kennedy into the form entry system of Day to create a profile generator for storing the car buyer profile for future use.

As to the claimed "entering data into a database", Nishiyama discloses (Fig. 2) a form entry system wherein the enter data can be stored in a specific database (2) (Column 5, lines 50-57). It would have been obvious to the person of ordinary skill in the art to recognize that writing and reading data from a database is well known in the art.

Regarding claim 2, Kennedy discloses (fig. 2) the controller (client computer 204) is adapted to enable a user to define the content of the store (Profile generator 205c defines the content of the stored data).

Regarding claim 4, note the rejection as set forth above with respect to claim 10.

Regarding claim 5, note the rejection as set forth above with respect to claim 11.

Regarding claim 6, note the rejection as set forth above with respect to claim 12.

Regarding claims 7-9, note the rejection as set forth above with respect to claims 13-15.

***Response to Arguments***

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Regarding claim 3.

The Applicant argues, at pages 6-7, by asserting that Atlas does not disclose the new added limitation "displaying at least one further data entry field corresponding to each of at least two data values which are capable of being entered in the one data entry field". The 102 rejection based on the Atlas reference is withdrawn from consideration.

In response to applicant's argument that the Day reference and the Kennedy reference can not be combined (pages 7-8), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Regarding to the new added limitation "displaying at least one further data entry field corresponding to each of at least two data values which are capable of being entered in the one data entry field", Day further discloses (Fig. 4) one further data entry

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field (menu 50) corresponding to each of at least two data value (Year 19780 to year 1986) which are capable of entered in the one data entry field (Year highlighted box 51).

Regarding claims 10-15.

Note the rejections as set forth above with respect to claims 10-15.

Regarding claims 1-2 and 4-9.

The Applicant argues, at pages 8-10, by asserting "Day does not disclose or suggest storing data values and corresponding attribute data defining at least one further data entry field for each of at least two data values which may be entered in the one data entry field". The examiner respectfully disagrees.

Day discloses (Figs. 3 and 4) a method for controlling the appearance of a data entry form on a display (form 30 on a display 15). The method comprises the step of causing a data entry form (30) to be displayed on a display (15) in accordance with stored attributes (highlighted attribute) (Column 3, lines 47-51). The data entry form (30) having at least one data entry field (Fig. 3, entry field 41), wherein a user can inserts the word "CONVERTIBLE" model for the entry field (41). As shown in Fig. 4, upon inserts the name "CONVERTIBLE", the form entry system dynamically altering the data entry form and the display of the data entry form by highlighting the next filed and bring up the corresponding tool (5) to fill in that field (Column 3, line 63 to column 4, line 2). Day also discloses (Figs. 8-9) a corresponding further data entry field (fields 85-1 to

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85-7) for each of at least two data values (fields 85-1 to 85-7 are at least two data values).

Regarding to the limitation “displaying at least one further data entry field corresponding to each of at least two data values which are capable of being entered in the one data entry field”, Day further discloses (Fig. 4) one further data entry field (menu 50) corresponding to each of at least two data value (Year 19780 to year 1986) which are capable of being entered in the one data entry field (Year highlighted box 51).

Furthermore, the statements of intended use or field of use, “operable to”, “adapted to”, or “**capable of**” clause are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentable distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2<sup>nd</sup> 1647.

See MPEP 2114:

“A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2<sup>nd</sup> 1647.



Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ 2<sup>nd</sup> 1525, 1528."

As set forth in MPEP 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

In response to applicant's arguments against the Nishiyama reference individually (page 10), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUU MATTHEW whose telephone number is (571) 272-7663. The examiner can normally be reached on Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JACK KEITH can be reached on (571) 272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Luu

A handwritten signature in black ink, appearing to read 'Matthew Luu', with a large, stylized initial 'M'.

**MATTHEW LUU**  
**PRIMARY EXAMINER**